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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

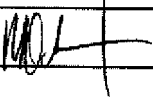
Docket Number (Optional)

10022/182

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on June 25, 2008

Signature



Typed or printed name

Robert D. Summers, Jr.

Application Number

10/071,936

Filed

February 7, 2002

First Named Inventor

ECKLUND

Art Unit

2143

Examiner

Bilgrami, Asghar H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

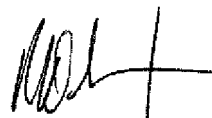
☒

attorney or agent of record.

Registration number 57,844☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

Robert D. Summers

Typed or printed name

312-321-4200

Telephone number

June 25, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

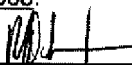
☒\*Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Robert D. Summers, Jr., Reg. No. 57,844

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Appln. of: ECKLUND et al.

Appln. No.: 10/071,936

Filed: February 7, 2002

For: RETRIEVING DOCUMENTS OVER  
A NETWORK WITH A WIRELESS  
COMMUNICATION DEVICE

Attorney Docket No: 10022/182

Examiner: Asghar H. Bilgrami

Group Art Unit: 2143

Confirmation No. 9850

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Assignee requests review of the final rejection in the above-identified application.  
No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

## REMARKS

The Office Action dated April 04, 2008, rejected claims 1, 4, 6, 10-12, 15-18, 20 and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over Ollikainen (U.S. Patent Publication No. 2003/0074475 A1) in view of Ndili (U.S. Patent Publication No. 2002/0161928 A1).

**I. The rejections under 35 U.S.C. § 103(a) are clearly erroneous because the combination of cited references fails to teach or suggest a proxy server configured to generate and transmit a navigation aid.**

The Office Action, at pages 3-4 and 6-7, asserts that regarding independent claims 1, 6, 11, 15, 16, 17 and 28, Ndili discloses a proxy server configured to generate a navigation aid and transmit said navigation aid. However, Ndili at ¶ 0084 indicates that the next segment may be indicated with a user-interactive feature (icon) to show the availability of a next segment and that if a next segment is a last segment, then the last segment is signaled to mobile device as the last segment. No where does Ndili teach or suggest that the user-interactive feature (icon) disclosed therein is generated and transmitted. The Office Action fails to provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged characteristic necessarily flows from the teachings of the applied references. The fact that the last segment is 'signaled' to the mobile device as the last segment, as disclosed in ¶ 0084 of Ndili, does in no way disclose or suggest a proxy server configured to generate a navigation aid and transmit said navigation aid to a wireless communication device.

The Assignee's Response dated November 19, 2007 (hereinafter the "Response") demonstrated at page 19 that even if the combination of Ollikainen and Ndili is proper, which it is not, the Ollikainen-Ndili combination does not teach or suggest a proxy server configured to generate a navigation aid and transmit a viewable segment and said navigation aid, as claimed. Claim 1 further recites that the navigation aid is selectable. The Application at ¶ 0037 indicates that the wireless communication device processing application encodes and transmits a viewable segment to the wireless communication device, along with a navigational aid.

MPEP §2141 provides that to establish a prima facie case of obviousness under 35 U.S.C 103(a) an examiner is required to resolve factual inquiries according to *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The requirement of resolving these factual inquiries was recently reiterated by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, (CITE) 82 USPQ2d 1385 (2007). Among these factual inquiries, an Examiner must accurately determine the scope and content of the prior art. See MPEP §2141(II.A.). In the present application, the Office Action errs in determining the content of the relied-upon references. In particular, neither Ollikainen nor Ndili describe a proxy server configured to generate and transmit a navigation aid.

"[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (U.S. 2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). However, the Office Action fails to identify any portion of either Ollikainen or Ndili that describes a proxy server configured to generate and transmit a navigation aid. Thus, the rejections of independent claims 1, 6, 11, 15, 16, 17 and 28 lack any articulate reasoning to sustain the findings of obviousness.

To establish that missing descriptive material is inherent, the "evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); see, also, MPEP § 2112, IV. The Office Action fails to provide any technical rationale to support a suggestion that Ndili, alone or in combination with Ollikainen, inherently describes a proxy server configured to generate and transmit a navigation aid.

Ollikainen and Ndili cannot be properly combined because there exists no reasonable expectation that the combination would yield the claimed invention. Prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); see also MPEP 2143.02. Ollikainen and Ndili, in combination, at best may teach or suggest generating and transmitting a signal to a mobile device where a user-interactive feature (icon) resides that is used to indicate a next segment. However, since a combination of Ollikainen and Ndili does not result in a proxy server configured to generate and transmit a navigation aid viewable at a wireless communication device, as claimed, the Office Action fails to establish a prima facie case of obviousness.

Based on the above remarks, the Office Action assertions are clearly erroneous because the combination of cited references fails to disclose the limitations and features of independent claims 1, 6, 11, 15, 16, 17 and 28. Therefore, claims 1, 6, 11, 15, 16, 17 and 28, and the dependent claims that depend from 1, 6, 11, 15, 16, 17 and 28 are patentable over the references.

**II. The rejections under 35 U.S.C. § 103(a) are clearly erroneous because the Office Action errs in determining the scope and content of the prior art.**

Claim 25, which depends from independent claim 17, describes generating a menu with a wireless communication device, wherein the menu includes a plurality of menu items, where the menu items include an integration and application programming interface (API) tools menu item, a technical services menu item, and a gateway services menu item. Claim 25 further describes the menu to include a plurality of menu items selectable with an input device included in said wireless communication device. In other words, the integration and application programming interface (API) tools menu item is a selectable menu item that is included in said wireless communication device. The Office Action asserts that the combination of Ollikainen and Ndili show all the features of claim 25. However, neither Ndili nor Ollikainen, alone or in combination, teach or suggest the menu items and their combination as recited in claim 25.

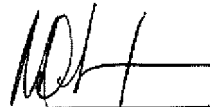
Ndili, at ¶¶ 0136-0137, 0145-0146, 0149 and 0151 and Figure 11, describes an operator-interface available to operators to provide solutions for mobile devices that with selection fields that include user-interactive features such as menus. No where does Ndili teach or suggest that the operator-interface is a menu generated with a wireless communication device, wherein the menu includes a plurality of menu items, where the menu items include an integration and application programming interface (API) tools menu item, a technical services menu item, and a gateway services menu item. Thus, Ndili, alone or in combination with Ollikainen, does not teach or suggest all the features of claim 25. For at least the above reasons, claim 25 is patentable over the references.

### Conclusion

The 35 U.S.C. § 103(a) rejections are improper and clearly erroneous, and the references, alone or in combination, fail to teach or suggest all the limitations and features of the pending claims. For at least the above reasons, Assignee respectfully requests review of the final rejection directed against the current application and withdrawal of the rejections against the claims.

**BRINKS  
HOFER  
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& LIONE**

Respectfully submitted,



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